

6/19/01

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Paper No. 14

EWB

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Ocean Enterprises, Inc.

Serial No. 75/469,984

Allan M. Loew of Loew, Hauptman, Gopstein, Gilman & Berner
for Ocean Enterprises, Inc.

Rudy R. Singleton, Trademark Examining Attorney, Law Office
109 (Ron Sussman, Managing Attorney).

Before Cissel, Hanak and Drost, Administrative Trademark
Judges.

Opinion by Hanak, Administrative Trademark Judge:

Ocean Enterprises, Inc. (applicant) seeks to register
THE PUBS OF ----- for "t-shirts and sweatshirts." The
application was filed on April 20, 1998 with a claimed first
use date of September 1989. While the application did not
make specific reference to Section 2(f) of the Trademark
Act, the application did contain a statement that "the mark
has become distinctive of the goods of applicant as a result
of substantially exclusive and continuous use thereof by
applicant for over five years." At page 2 of his brief, the
Examining Attorney acknowledges that "the application was

filed under Section 2(f) of the Act."

The Examining Attorney has refused registration on two grounds. First, the Examining Attorney contends that applicant is impermissably seeking to register a "phantom" trademark. Second, citing Trademark Rule 2.72, the Examining Attorney contends that applicant's drawing depicting the mark THE PUBS OF ----- is materially different from any of the trademarks depicted in applicant's specimens of use, such as THE PUBS OF DENVER and THE PUBS OF PALM SPRINGS. Continuing, the Examining Attorney argues that applicant cannot amend its drawing to insert the name of a particular geographic location in lieu of the seven dashes because this would constitute a material alteration of the drawing which is prohibited by Trademark Rule 2.72.

When the refusal to register was made final, applicant appealed to this Board. Applicant and the Examining Attorney filed briefs. Applicant did not request a hearing.

We consider first the refusal based upon the Examining Attorney's contention that applicant is impermissibly seeking to register a "phantom" trademark. Our primary reviewing Court has defined a "phantom" mark as follows: "A 'phantom' trademark is one in which an integral portion of

the mark is generally represented by a blank or dashed line acting as a place holder for a generic term or symbol that changes, depending on use of the mark." In re International Flavors & Fragrances, Inc., 183 F.3d 1361, 51 USPQ2d 1513, 1514 at footnote 1 (Fed. Cir. 1999). Applicant acknowledges that the dashes in its drawing represent different geographic locations. (Applicant's brief page 1). Indeed, applicant admits that as of "the time the application was filed, applicant had sold THE PUBS OF ----- shirts with 89 different [geographic] locations, as specified on the specimens." (Applicant's brief page 2). Applicant also states that as of the time of its appeal, it was currently selling "THE PUBS OF ----- shirts for 138 different [geographic] locations." (Applicant's brief page 2).

In view of the foregoing, it is clear that applicant's mark as depicted in its drawing (THE PUBS OF -----) is a phantom mark. Our primary reviewing Court, referencing Section 1 of the Trademark Act, has made it clear that "a trademark registrant may seek to register only a single mark in a registration application, and trademark applications seeking to register 'phantom' marks violate the one mark per registration [application] requirement." International

Flavors, 51 USPQ2d at 1518.

Accordingly, the refusal to register on the basis that applicant is seeking to register a phantom mark is affirmed.

Applicant attempts to distinguish the facts of this case from the facts of International Flavors by arguing that the marks in International Flavors "were much more nebulous than the mark sought to be registered by applicant."

(Applicant's brief page 5). Applicant's reasoning is fatally flawed for two reasons. First, even if the dashes in applicant's drawing represented just two different geographic locations, applicant's proposed "mark" would still violate the one mark per application requirement set forth by the Court in International Flavors. 51 USPQ2d at 1518. Second, in reality, there are literally hundreds of thousands of geographic names for various countries, territories, provinces, states, cities, towns and streets. (The foregoing does not even count the plethora of geographic names for various physical features such as oceans, gulfs, bays, rivers, mountains etc.). We will not speculate as to whether the number of geographic names is greater than or less than the number of names of various herbs, fruits, plants and vegetables, the phantom elements

in the International Flavors case. Suffice it to say that the number of geographic names is so vast that applicant's statement at page 7 of its brief that a member of the public would have no problem in conducting a trademark search if applicant obtained a registration of THE PUBS OF ----- covering all geographic locations is simply not plausible.

Before leaving the issue of the phantom mark refusal, one comment is in order. At pages 3 and 6 of its brief, applicant appears to be arguing that it seeks to register but a single mark, namely, THE PUBS OF. Applicant states that many of its customers refer to its different shirts as THE PUBS OF shirts "without using a place identifier." (Applicant's brief page 3). In this regard, applicant makes reference to the declaration of its president (William Regan) wherein Mr. Regan states that applicant has sold approximately 1,400,000 of its THE PUBS OF----- shirts and that applicant's customers consider applicant's THE PUBS OF ----- shirts as coming from a single source regardless of the place identifier on the shirt. Two points need to be clarified. First, for the reasons set forth in this Board's order of September 15, 2000 the declaration of Mr. Regan was not properly made of record in this proceeding. While we

have read the declaration, we have given no weight to it, as requested by the Examining Attorney. Second, to the extent that applicant's customers view the three word term THE PUBS OF as referring solely to applicant, applicant is quite free to file an application seeking to register just these three words without any place identifier.

As for the second ground of refusal, that applicant's drawing featuring THE PUBS OF----- differs materially from the marks shown on applicant's specimens, we agree with the Examining Attorney that there is a material difference, and that hence applicant cannot be permitted to amend its drawing to feature one of the actual marks shown on its specimens, such as THE PUBS OF DENVER. Obviously, the mark THE PUBS OF DENVER differs materially both from the mark shown in the drawing (THE PUBS OF -----) or simply THE PUBS OF.

Likewise, applicant cannot submit a substitute specimen conforming to the drawing THE PUBS OF ----- because, as applicant states at page 4 of its brief, applicant "has never sold a shirt with the mark THE PUBS OF -----."

Finally, we would be remiss if we did not note that in support of its request to amend its drawing, applicant cites

Ser. No. 75/469,984

In re ECCS Inc., 94 F.3d 1578, 39 USPQ2d 2001 (Fed. Cir. 1996). Applicant's reliance on this case is misplaced because effective October 30, 1999 the Trademark Rules were changed to make it clear that "amended Trademark Rule 2.72 prohibits any amendment which materially alters 'the mark' and amended Trademark Rule 2.52(a) clarifies that 'the mark' sought to be registered is the mark which appears on the drawing." In re Who? Vision Systems Inc., 57 USPQ2d 1211, 1217 (TTAB 2000).

Decision: The refusal to register on both grounds is affirmed.

